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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,892	07/10/2001	Satoshi Tamai	Q65348	9564

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SUGHRUE, MION, ZINN,
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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,892

Applicant(s)

TAMAI, SATOSHI

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6 and 11-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 11-24 is/are rejected.
- 7) ☒ Claim(s) 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/30/02</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment of 11/30/04 has been entered. The examiner has included a copy of the 8/30/02 IDS as applicant has requested.

1. Claim 22 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 20 recites two dealer terminals (a 1st and 2nd). This is the reciting of two distinct terminals. Claim 22 is attempting to recite that the two terminals are really one terminal, which is broadening out of the scope of the claim, not a further limiting of the claim. This is also addressed under 35 USC 112, 2nd paragraph.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 22, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 6, there is no antecedent basis for "said communication link". No communication link has previously been claimed so what does this refer to? Is this a communication link between the 1st dealer terminal and the server, the 2nd terminal and the server, or a communication link for both? The previous language to a

communication line was deleted and claim 5 recites no communication link (or line) of any kind.

For claim 22, the scope is not clear. Claim 20 recites two dealer terminals (a 1st and 2nd). This is the reciting of two distinct terminals. Claim 20 clearly requires two terminals. Claim 22 is attempting to recite that the two terminals are really one terminal. The examiner has a problem with this language. It is not clear in claim 22 if there are two or just one terminal. Claim 22 includes all that was claimed for claim 20, so if claim 20 requires two terminals, how can there only be one in claim 22?

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,11,13,16,19, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Motoring Matters-Vehicle Ownership" (Singapore's Land Transport Authority Private Car Rental Scheme started in 1996) in view of Tornetta (5032989).

For claim 1,2,16, LTA in 1996 started a program that allowed private individuals to rent out their car to another individual. The LTA web page discloses features about the program and states that for step 1,

"Decide whether you want to:

Get VICOM Ltd (Tel: 6458 4555) to do it for you; or

Rent out the car yourself

Not disclosed is how VICOM (a company) would go about renting out your car for you. In renting a car it necessarily follows that you need to find a person willing to rent the car and that person needs to be able to find the person who has a car to rent.

Tornetta discloses a system for real estate properties that takes information from a person wishing to sell or rent their property, stores the information in a searchable database, and allows potential buyers or renters to search for desired property using user defined search criteria. Tornetta discloses a system that can match a seller to a buyer (or an owner of a rental property to a potential renter). Tornetta discloses a first dealer terminal 500, a dealer server 200, a 2nd dealer terminal 100, and a communication link 20. The communication link satisfies the claimed "intranet".

Column 10, lines 22-35 disclose the recited steps of first customer information being processed by the first dealer terminal and being transmitted to the dealer server 200.

Column 10, lines 15-21 disclose the steps of the dealer server processing the first customer information and transmitting information (results of a search) to the second dealer terminal. The dealer terminal receives the transmitted information and provides it to the 2nd customer. The recited "producing a rental reservation information by said second dealer terminal" is interpreted to be the step of sending the search criteria about the rental from the 2nd dealer terminal to the dealer server 200 (prior to receipt of the search results). The term "rental reservation information" as an example can include the date of desired rental, which is information that is part of the search request. This part of the claim is broad and is not reciting the sending of an actual reservation request

for the rental. The search request sent from the 2nd dealer terminal is received by the dealer server and processed to yield search results. The language "to transfer said rental reservation information to said first dealer terminal and to and to amend said private car availability stock for the region..." are not positively reciting that any transfer is being done or that any amending is being done. This language is simply reciting the intended use of the "receiving and processing" step done by the dealer server. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a system as disclosed by Tornetta to match a person wishing to rent a car with a person who has a car to rent in Singapore. The recitations to the types of data (unused period information, car model, location) necessarily follow from the 103 combination. When renting a car the data being processed will be data relevant to cars, not real estate properties, although some data will be the same (location, unused time period, price).

For claims 11, 19, Tornetta discloses that the "Display/Update" option allows one to update data on a property listing (or in the case of the 103 combination, this feature allows data concerning the renting of a car to be updated). Tornetta also allows for new listing to be entered into the system.

For claim 13, the dealer server, and both dealer terminals are connected by a communication link and this satisfies the claimed limitation of "internet", which after all is simply a connecting of computers together so they can communicate with each other.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 5,6,12,14,15,17,18,20-24, are rejected under 35 U.S.C. 102(b) as being anticipated by Tornetta (5032989). Applicant should take notice that in the pending article claims, the recitations directed to the kind of data that is being processed is considered to be non-functional descriptive material that does not serve as a limitation. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The fact that the system is “for renting a car” does not distinguish over a system for renting homes as the only difference is the kind of data being processed (car data versus homes data). Applicant should also take notice that language such as “a first dealer terminal to produce a first customer information” is taken as only reciting a terminal with the intended use being to produce information. As long as the prior art is capable of the claimed functional language (intended use language) the prior art is properly applied. In this case, most of the recited functions are found in Tornetta but applicant’s attempt to define the article in terms of what it is “to do” or “would do” is simply reciting the intended use of the system.

For claims 5,17,20-24, Tornetta discloses a system for the selling or renting of a home. The first dealer terminal is 500 and the dealer server is 200. The first customer information is taken to be non-functional descriptive material but the examiner also notes that the information processed by Tornetta will be of the same nature (unused period where rental is possible, model type, and rental location). Tornetta is fully

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capable of and/or discloses the transmitting of the information to the dealer server as claimed. The dealer server processes the information as claimed. The claimed availability information and availability stock is another example of non-functional descriptive material but this kind of data is also found in Tornetta (because Tornetta will produce information on available stock of homes and home availability information). The 2nd dealer terminal provides information to the customer as claimed. With respect to the language about what would happen if a customer makes a rental request, because the claim covers the situation where the customer does not make a rental request (did not find anything they want to rent or that they can afford), the rest of the claim is not required. On the other hand, this language can also be satisfied by the fact that the dealer server can accept a search request from the 2nd dealer terminal. The search request is a request for information on a rental (i.e. a transmission of rental reservation information), so Tornetta discloses a system that can operate as claimed even if the “would produce” language is considered. The server confirming or denying the request can be interpreted as determining whether or not there are any valid search results based on the search criteria.

For claims 6,14, the dealer server, and both dealer terminals are connected by a communication link and this satisfies the claimed limitation of “intranet” or “internet”, which after all is simply a connecting of computers together so they can communicate with each other.

For claims 12,18, Tornetta discloses that the "Display/Update" option allows one to update data on a property listing. This is amending of the first customer information as claimed. Tornetta also allows for new listing to be entered into the system.

For claim 15, the claim is reciting how the dealer terminals are to be used, and this is not considered as reciting anything further to the system. Tornetta is fully capable of being used in the claimed manner. A user of either terminal (1st or 2nd) can use the terminal to make a listing or search for a rental property.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Keithley et al. (5584025), Janssen (5754850), and Ingraham et al. (20010037280) disclose systems that match a seller to a buyer and are relevant to what is claimed. Applicant should take notice that Keithley and Janssen are directed to use in a real estate environment, but that both references also disclose that such a system can be used for cars as well as other types of products for sale or rent. "AsiaOne Motoring" discloses an article that references the LTA private car rental scheme that was started in 1996.

9. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER